

REMARKS

Applicant thanks the Examiner for the indication that claims 13-29 are allowable. Claims 1-41 were pending. Applicant has canceled claims 1-12 and 30-41, leaving only claims 13-29 pending. Applicant has amended claims 25 and 28 to make these claims dependent only on the pending claims. Accordingly, claims 13-29 remain pending. No new matter has been added.

Rejections Under 35 U.S.C. § 102

1. Applicant acknowledges the withdrawal by the Examiner in the Office Action of the rejection of claims 1-41 under 35 U.S.C. § 102(a) as being anticipated by the Timmons et al. reference and the rejection of claims 13-29 under 35 U.S.C. § 102(e) as being anticipated by the Fire patent (US 6,506,559 B1).

2. The Examiner rejected claims 30-41 under 35 U.S.C. § 102(e) as being anticipated by the Fire patent (US 6,506,559 B1). Applicant respectfully disagrees, but for advancing the prosecution has canceled these claims from this application. Accordingly, Applicant respectfully requests withdrawal of the rejection.

Applicant respectfully wishes to make one note of clarification regarding the teachings of the Fire provisional application (US 60/068,562) that serves as the priority document for the Fire patent.

The Examiner asserted on page 5 of the Office Action that the Fire patent has the benefit of the Fire provisional application with respect to the use of bacteria to generate dsRNA. Applicant respectfully disagrees on the basis that the disclosure of the Fire provisional application is insufficient as a matter of law under 35 U.S.C. § 112, first paragraph, to serve as the 102(e) date with respect to the noted subject matter.

The Fire provisional application does not describe production of dsRNA by micro-organisms. Based on page 7, lines 10-15 of the Fire application, it is clear that Fire is referring to production of dsRNA inside the target cell, not by a micro-organism such as a bacteria. On page 7, line 12, the application states that the “Endogenous RNA polymerase of the cell may mediate transcription *in vivo*...”, and the only cell referred to in that paragraph is “the cell with the target gene” (line 10), not a bacterium.

Therefore, the Fire provisional application contains no disclosure of the referenced subject matter, and the Fire patent should not have the benefit of the Fire provisional application filing date with respect to this subject matter.

3. The Examiner rejected claims 1-4, 6-10, 30, and 32-40 under 35 U.S.C. § 102(b) as anticipated by Brenner as evidenced by Derrick et al. Applicant respectfully disagrees.

Applicant wishes to note that the Brenner reference does not teach the presence of an expression vector that encodes and produces dsRNA.

However, in order to advance the prosecution of this application, Applicant has canceled claims 1-4, 6-10, 30, and 32-40, and therefore respectfully requests withdrawal of the rejection.

4. The Examiner rejected claims 1-4, 6-10, 30, and 32-40 under 35 U.S.C. § 102(b) as anticipated by Kessin. Applicant respectfully disagrees.

Applicant wishes to note that the Kessin reference does not teach the presence of an expression vector that encodes and produces dsRNA.

However, in order to advance the prosecution of this application, Applicant has canceled claims 1-4, 6-10, 30, and 32-40, and therefore respectfully requests withdrawal of the rejection.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
Plaetinck, et al, Applicant

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